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Attorney Docket No. 24-008

**REMARKS**

Claims 1-9, 11-14 and 16 are pending. Claims 10 and 15 have been canceled. Claims 5-6 have been withdrawn. The applicants respectfully request reconsideration and allowance of this application in view of the above amendments and the following remarks.

Claims 1-4 and 7-16 were rejected under 35 USC 112, first paragraph, as failing to comply with the written description requirement. The applicants respectfully request that this rejection be withdrawn for the following reasons.

The phrase "a higher release force" and "a lower release force" are deemed to be new matter. Claims 10 and 15 include this phrase. By way of the above amendment, claims 10 and 15 are canceled. Withdrawal of the rejection with respect to claims 10 and 15 is respectfully requested.

With regard to independent claims 1 and 3, the office action states that the exact phrase "the base material being of a different material than the adhesive layer" cannot be found in the specification, and therefore is considered to be new matter. The applicants traverse the procedural validity of this rejection.

The following steps must be followed before a rejection can be made on the basis of failure to comply with the written description requirement:

(A) Each claim must be separately analyzed and given its broadest reasonable interpretation in light of and consistent with the written description. See, e.g., *In re Morris*, 127 F.3d 1048, 1053-54, 44 USPQ2d 1023, 1027 (Fed. Cir. 1997).

(B) Prior to determining whether the disclosure satisfies the written description requirement for the claimed subject matter, the examiner should review the claims and the entire

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specification, including the specific embodiments, figures, and sequence listings, to understand how applicant provides support for the various features of the claimed invention.

(C) The examiner must determine whether there is sufficient written description to inform a skilled artisan that applicant was in possession of the claimed invention as a whole at the time the application was filed. When an explicit limitation in a claim "is not present in the written description whose benefit is sought it must be shown that a person of ordinary skill would have understood, at the time the patent application was filed, that the description requires that limitation." *Hyatt v. Boone*, 146 F.3d 1348, 1353, 47 USPQ2d 1128, 1131 (Fed. Cir. 1998). See also *In re Wright*, 866 F.2d 422, 425, 9 USPQ2d 1649, 1651 (Fed. Cir. 1989) (original specification for method of forming images using photosensitive microcapsules which describes removal of microcapsules from surface and warns that capsules not be disturbed prior to formation of image, unequivocally teaches absence of permanently fixed microcapsules and supports amended language of claims requiring that microcapsules be "not permanently fixed" to underlying surface, and therefore meets description requirement of 35 U.S.C. 112.); *In re Robins*, 429 F.2d 452, 456-57, 166 USPQ 552, 555 (CCPA 1970) ("[W]here no explicit description of a generic invention is to be found in the specification[,] ... mention of representative compounds may provide an implicit description upon which to base generic claim language.").

It is improper for the examiner to consider only one of the foregoing steps. In the present case, the Examiner has ignored at least steps (B) and (C). Furthermore, "the examiner has the initial burden ... of presenting evidence or reasons why a person skilled in the art would not recognize that the written description of the invention provides support for the claims. (MPEP § 2163.) The examiner must provide a reasonable explanation as to why the claims contain subject matter which is not recognized in the written description. (See *Id.*).

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It appears that the reason the examiner did not find support for the base material being of a different material than the adhesive layer is that the examiner requires the exact phrase to appear in the specification. To the contrary, there is no *in haec verba* requirement; claim limitations can be supported in the specification through express, implicit, or inherent disclosure. MPEP 2163(I)(B). Therefore, the examiner's explanation as to why the subject matter is not in the written description is unreasonable.

Because the Examiner has not considered the above-discussed steps in the rejection, it is respectfully requested that the rejection of claims 1-4 and 7-16 under 112, first paragraph be withdrawn. If the rejection is not withdrawn, the Examiner must present evidence of why the written description is insufficient so that applicant can properly prepare a response.

Assuming *arguendo* that the Examiner maintains the rejection of claims 1-4 and 7-16 under 35 U.S.C. 112, first paragraph, the applicants will address the merits of the rejection.

The specification as filed describes the material of the base material on page 11, line 14 to page 12, line 9; and the material of the adhesive layer on page 10, line 22 to page 11, line 5. The specification as filed discloses, for example, on page 10 that: "The pressure sensitive adhesives may be, for instance, acrylic type, polyester type, urethane type, rubber type and silicone type ones, as well as curable pressure sensitive adhesives. Examples of curable adhesives are radiation-curable adhesives such as energy rays-curable adhesives and heat-curable adhesives."

The specification as filed discloses, for example, on page 11 that "For instance, when the base material 4 is used as a cover sheet for the recording layer of an optical disk, resins such as polycarbonate, poly (methyl methacrylate), polystyrene and the like may be selected as the material for the base material 4. Alternatively, when the base material 4 is, for instance, used as

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a film for a display of PDA or the like, resins, for instance, cellulose esters such as cellulose diacetate, cellulose triacetate and cellulose acetate butyrate; polyesters such as polyethylene terephthalate and polybutylene terephthalate; polyolefins such as polyethylene and polypropylene; polyamides; polyimides; polyvinyl chlorides; poly (methyl methacrylate); polycarbonates; and polyurethanes may be selected as the material for the base material 4.”

Furthermore, two examples of the invention are provided in the specification as filed. An example of the invention is described on page 23, wherein the base material is “a polycarbonate film (Pure Ace C110-75 ...)” and a pressure sensitive adhesive of “one part by weight of a poly(isocyanate) compound ... added to 100 parts by weight of a copolymer obtained by copolymerizing 98 parts by weight of butyl acrylate with 2 parts by weight of acrylic acid, then 200 parts by weight of ethyl acetate...” Another example of the invention is described on page 25, where “an acrylic type pressure sensitive adhesive (PL SHIN ...) was applied onto a base material constituted by a polyethylene terephthalate film ...” In these examples, the base material is a different material than the adhesive layer, and would be understood to be a different material.

In summary, the specification discloses that the base material can be made from a variety of materials, and the adhesive layer can be made from other materials which are different from the base material. Specific examples are provided where the base material is of a different material than the adhesive layer. Therefore, because the specification describes the material of the base material being of a different material than the adhesive layer, it is respectfully requested that the rejection of claims 1-4 and 7-16 under 35 USC 112, first paragraph be withdrawn.

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Claims 1, 3, 7-9 and 11-14 were rejected under 35 USC 103(a) as being unpatentable over DE 599,159 ("159"). The applicants respectfully request that this rejection be withdrawn for reasons including the following, which are provided by way of example.

The examiner improperly refused to examine the current claims, i.e. provided in the Amendment filed 23 March 2006. The office action states that the phrases "the base material being of a different material than the adhesive layer" "have not been considered for the purpose of examination of the instant claims." It is an abuse of discretion for the examiner to refuse to consider the claims as amended on 23 March 2006. 37 CFR 1.112 (applicant is entitled to amend the claims unless the rejection is final). It is the claimed invention which is examined (37 CFR 1.104(a)(1)), not some construction of claims cobbled together by the examiner including and/or excluding some amended language in the claims. Therefore, the finality of the office action must be withdrawn and the examiner must examine the current claims.

The office action states that the examiner has not considered the phrase "the base material being of a different material than the adhesive layer." To the contrary, the examiner must consider the subject matter added to the claim in making rejections based on prior art, despite the new matter rejection. MPEP 2163.06 ("The examiner should still consider the subject matter added to the claim in making rejections based on prior art since the new matter rejection may be overcome by applicant"). Accordingly, the examiner's failure to consider the claim language is in error.

Claim 1 recites, in combination, for example, a long release sheet; an adhesive layer in continuous contact and coextensive with the release surface of the release sheet; a base material with a first surface and a second surface opposite to the first surface, the first surface being in continuous contact and coextensive with the adhesive layer opposite to the long release sheet.

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The base material is of a different material than the adhesive layer. Also, there is a protective material provided on the second surface of the base material, as further recited.

Claim 3 recites, in combination, for example, a long release sheet; an adhesive layer in continuous contact and coextensive with the release surface of the release sheet; a base material in continuous contact and coextensive with the adhesive layer opposite to the long release sheet. The base material is of a different material than the adhesive layer. Also, there is a protective material provided on the back surface of the release sheet, as further recited.

Without conceding that '159 discloses any feature of the present invention, '159 is directed to a laminate sheet comprising an adhesive strip provided with adhesive and elevations consisting of non-adhesive wafers of "paper or similar material." According to the English translation, "The adhesive can run over the entire surface of the adhesive strip. In addition, it can be omitted in the centre, as indicated in Figures 1 to 3, since it suffices if the wafers are only stuck firmly onto part of its surface."

To properly reject a claimed invention, the examiner must establish a *prima facie* case of obviousness. To establish a *prima facie* case of obviousness with respect to a claimed invention, all the claim limitations must be taught or suggested by the prior art reference (or references when combined). *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). Moreover, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Furthermore, the teaching or suggestion to make the claimed combination and a reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

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The examiner bears the burden of establishing this *prima facie* case. *In re Deuel*, 34 U.S.P.Q.2d 1210, 1214 (Fed. Cir. 1995). The applicant for patent may then attack the *prima facie* case as improperly made out, or present objective evidence tending to support a conclusion of nonobviousness. *In re Fritch*, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992).

Where, as here, the examiner fails to establish a *prima facie* case of obviousness, the applicant has no burden to rebut the rejection of obviousness with evidence. *In re Rijckaert*, 28 U.S.P.Q.2d 1955, 1957 (Fed. Cir. 1993). If the examination at the initial stage does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of patent. *In re Oetiker*, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992).

The office action asserts that '159 discloses an invention propounded by the examiner (but not presently claimed), although the examiner admits that '159 does not disclose the base material in continuous contact and coextensive with the adhesive. However, the examiner takes a position that the base material and the adhesive can be of the same material. The examiner improperly ignores the limitation in the claims, "the base material being of a different material than the adhesive layer."

To the contrary, '159 fails to teach or suggest the invention, as presently claimed, when the amended claims are considered as a whole. Examples are provided below of elements which are neither taught nor suggested by '159.

'159 fails to teach or suggest that the base material is of a material different from the adhesive, and fails to teach or suggest both an adhesive layer and a base material. (See, e.g., claims 1 and 3.) The office action admits this, and states that the "Examiner has taken the position that the base material and the adhesive are of the same material, in the absence of any

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showing otherwise." Therefore, '159 fails to teach or suggest the separate base material and adhesive layer.

Furthermore, the office action improperly cites the same elements of '195 as teaching different elements recited in independent claims 1 and 3. In claims 1 and 3, the order of the sheet, layer, and materials is different. For example, claim 1 recites a protective material provided on the second surface of the base material, but claim 3 in contrast recites a protective material provided on the back surface of the long release sheet. '195 fails to teach that the protective material can be provided on the second surface of the base material or alternatively on the back surface of the long release sheet. Accordingly, the same rejection cannot be applied to both claims 1 and 3.

Moreover, '195 fails to teach or suggest that the adhesive layer is on the release surface of the release sheet, and the protective material is provided on the back surface of the release sheet (claim 3). To the contrary, '195 shows that the wafers (protective material) are provided on the same side of the lining paper strip as the adhesive; '195 expressly requires the wafers to be on the same side of the lining paper strip as the adhesive because the wafers must be stuck to the adhesive.

'159 fails to teach or suggest, for example, these elements recited in independent claims 1 and 3. It is respectfully submitted therefore that claims 1 and 3 are patentable over '159.

The examiner has not even attempted to allege a *prima facie* case of obviousness with regard to the present claims, as listed in the Amendment filed 23 March 2006. Moreover, the examiner admits that at least one element recited in independent claims 1 and 3 is missing from the cited reference.



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For at least these reasons, the combination of features recited in independent claims 1 and 3, when interpreted as a whole, is submitted to patentably distinguish over the prior art. In addition, '159 clearly fails to show other recited elements as well.

With respect to the rejected dependent claims, applicants respectfully submit that these claims are allowable not only by virtue of their dependency from independent claims 1 and 3, but also because of additional features they recite in combination.

The applicants respectfully submit that, as described above, the cited prior art does not show or suggest the combination of features recited in the claims. The applicants do not concede that the cited prior art shows any element recited in the claims. However, the applicants have provided specific examples of elements in the claims that are clearly not present in the cited prior art.

The applicants strongly emphasize that one reviewing the prosecution history should not interpret any of the examples the applicants have described herein in connection with distinguishing over the prior art as limiting to those specific features in isolation. Rather, for the sake of simplicity, the applicants have provided examples of why the claims described above are distinguishable over the cited prior art.

The applicants respectfully request entry of the present amendment, because the amendment only involves canceling dependent claims, from which no other claims depend. The reasons for entry are as follows. First, the amendments to the claims are necessary to further clarify the claimed invention to the Examiner. Second, the amendments to the claims do not raise new issues requiring further search since the amendments involve canceling the claims. Third, the applicants respectfully submit that no new matter has been introduced. Fourth, the amendments to the claims place the application in better form for appeal by materially

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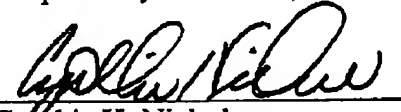
simplifying the issues, i.e., correcting formality requirements. Finally, no new claims are submitted, and two claims were canceled.

Accordingly, the applicants respectfully request entry of the present Amendment.

In view of the foregoing, the applicants submit that this application is in condition for allowance. A timely notice to that effect is respectfully requested. If questions relating to patentability remain, the examiner is invited to contact the undersigned by telephone.

If there are any problems with the payment of fees, please charge any underpayments and credit any overpayments to Deposit Account No. 50-1147.

Respectfully submitted,

  
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